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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/823,680

04/14/2004

Akihiko Seki

251857US0

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22850

7590

04/19/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

EXAMINER

FALASCO, LOUIS V

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/823,680

Applicant(s)

SEKI ET AL.

Examiner

Louis Falasco

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

PAPERS RECEIVED

Applicants' Amendment filed 01/23/06 is acknowledged.

CLAIMS

The claims are: 1 to 4, all claims are under consideration.

DETAILED ACTION

*Statutory Basis*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

*Rejections - 35 U.S.C. 103(a)*

1. Claims 1 to 3 are rejected as unpatentable under 35 U.S.C. 103(a) over **Meguro et al** (US 6890646) alone or in view of the admitted prior art for reasons of record.

*Rejections - Double Patenting*

2. Claims 1 to 4 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent Application No. **10/823,564** (corresponding to **Yajima et al** PG Pub 2004/0209121).

The double patenting rejection is maintained for reasons of record, in addition new claim 4 has been included; claim 9 of U.S. Patent Application No. 10/823,564 includes the product made by method steps sequence:

lower non-magnetic layer formation → upper magnetic layer formation →

back coat layer formation → calendering.

*Objection*

3. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable, as far as the 35 U.S.C. §103(a) rejection, if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4. As regards the double patenting rejection: timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) is required to overcome the provisional rejection based on a nonstatutory double patenting ground the conflicting application.

*Response to Arguments*

5. Applicants' arguments filed 01/23/06 have been fully considered but they have not been found persuasive in overcoming the rejections of claims 1 to 3 under 35 U.S.C. §103(a) and claims 1 to 4 rejected under the judicially created double patenting rejection.

- a. As a preliminary matter, applicants' comments that the Interview Summary should read that applicants representative argued Meguro et al does not disclose the process so concavities would not be inherent (page 13 last complete paragraph) has been agreed to by the examiner. The examiner agrees this is an accurate statement of the position expressed at the interview.
- b. Applicants argue that the product is achieved by a production process not fairly suggested by the **Meguro et al** alone or in view of the admitted prior art. This has been found convincing by the examiner for claim 4, which claims the product as a *product resulting from the process argued*, but has not been found convincing for claims 1 to 3 where the product is *not* claimed as the result of the argued process. It has been demonstrated that with the narrow process steps argued e.g., on pages 15 and 16 of applicants' Amendment' filed 01/23/06 results in a non-obvious product. The product produced by the process has been shown in Table 1 to result in a 3-12 fold unobvious improvement in Write error/MB over products where (1) opposing sides of a support has not been coated (Comparative Example 4) and (2) over products where opposing sides of the support have been coated with an intervening calendering step (Comparative Examples 1, 2 and 3). Claim 4 positively includes the product as being a product of these narrow process steps where the lower non-magnetic layer and upper magnetic layer and a back coated layer are formed, and calendering is only performed following completion of both (1) the formation of the lower non-

magnetic layer with drying and curing on the non-magnetic support and (2) the formation of the back coat layer on than opposing surface of the non-magnetic support with drying, resulting in a product commensurate in scope positively claiming as the product of the argued process sequence.

c. No arguments have been put forth against the Double Patenting rejection other than referencing MPEP §822.01 allowing for a provisional rejection. The rejection has been maintained. *A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) is required to overcome the provisional rejection based on a nonstatutory double patenting ground the conflicting application.*

#### SUMMARY

The claims are 1 to 4.

- Claims 1 to 3 has been rejected under 35 U.S.C. §103(a).
- Claims 1 to 4 are rejected under the judicially created doctrine of obviousness-type double patenting.
- Claim 4 is objected to, but would be allowable over the 35 U.S.C. §103(a) rejection if rewritten in independent form including all of the limitations of claim 1, which it depends on.
- Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting, but would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) is submitted to overcome the provisional rejection based on a nonstatutory double patenting ground the conflicting application.

**THIS ACTION IS MADE FINAL**

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**INQUIRES**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis Falasco, PhD whose telephone number is (571)272-1507. The examiner can normally be reached on M-F 10:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney, PhD can be reached at (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1773

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LF  
03/06



CAROL CHANEY  
SUPERVISORY PATENT EXAMINER